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IN THE

Supreme Court of the United States

OCTOBER TERM 1965

No. 1070

NELMOR CORPORATION,
Plaintiff Respondent,

v.

JERVIS CORPORATION
Defendant Petitioner.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

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Petitioner, Jervis Corporation, Defendant and Appellant in the courts below, prays that a Writ of Certiorari issue to review the Judgment herein of the United States Court of Appeals for the Sixth Circuit in so far as the same relates to all of the claims except Claims 2 and 20 of the patent to Jacobson No. 2,931.245.

The Opinion of the Court of Appeals affirming the Opinion and Judgment of the District Court for the Eastern District of Michigan, Southern Division, was released January 7, 1966 and a rehearing, without opinion, was denied on February 3, 1966. The judgment of the Court of Appeals was entered on January 7, 1966.

OPINIONS BELOW

The original Opinion of the United States District Court for the Eastern District of Michigan, Southern Division, was filed on April 27, 1964 and is reported only in the advanced sheets of U.S.P.Q. dated May 18, 1964 at 141 U.S.P.Q. 431 (Page 1 of the advanced sheets is attached to the rear of this Petition). Judgment was entered on April 29, 1964 (R 63a).

On or about May 12, 1964 the District Court altered its Opinion as originally filed by removing page 2 therefrom and substituting a new page 2. The Opinion of the District Court as altered is reported at 229 Fed. Supp. 864, 141 U.S.P.Q. 431 (R 51a). On May 12, 1964 the trial court filed a "Memorandum Supplementing Opinion Filed on April 27, 1964" (R 64a). The Supplemental Opinion is reported at 229 Fed. Supp. 871, 141 U.S.P.Q. 483.

The Opinion of the Court of Appeals for the Sixth Circuit is reported in the advanced sheets, 148 U.S.P.Q. 178 and is included in the certified record and printed in the Appendix.

JURISDICTION

This Court has jurisdiction under 28 U.S.C. Section 1254 (1).

This Petition is filed to have this Court exercise its power of supervision, because the Court of Appeals has sanctioned a departure by the trial court from the accepted and usual course of judicial proceedings.

STATEMENT OF QUESTIONS INVOLVED

1. Should the trial court, in a suit requesting a declaratory judgment of invalidity of a patent having twenty-four claims, have passed judgment on all of the claims when, during the trial, by understanding, acquiescence and agreement between counsel and the court, the issues were limited to and the case was tried on Claims 2 and 20 only, which were the claims alleged to have been infringed?

2. Does the trial court's original opinion, filed in lieu of findings of fact and conclusions of law and specifically directed to Claims 2 and 20 only, support a judgment holding all twenty-four claims of the patent "invalid, void and lacking in invention over the prior art"?

3. Does the trial court's opinion, altered twelve days after the judgment was entered by removing page 2 from the originally filed opinion and inserting a new page therefor to make it superficially appear that the opinion was directed to all of the patent claims, together with the trial court's supplemental opinion filed on February 12, 1964, support the judgment holding all of the patent claims "invalid, void and lacking in invention over the prior art" when no additional findings of fact were made?

STATEMENT OF THE CASE

Plaintiff Respondent filed a complaint requesting a declaratory judgment holding Jacobson Patent No. 2,931,245 for a "Remote Control Device, Particularly for an Automotive Rearview Mirror" invalid and not infringed. Petitioner answered and filed therewith a counterclaim charging infringement of claims 2 and 20 only. Other counterclaims were filed but they are not pertinent to this Petition. By acquiescence, consent and agreement between the parties and the court during the trial, the trial was limited to the issues of validity and infringement of claims 2 and 20 only, those being the claims alleged to have been infringed.

The court filed its opinion on April 27, 1964, in lieu of findings of fact and conclusions of law, and in that opinion expressly limited its decision to Claims 2 and 20 only (see photostat rear of Petition). Although the Court had limited its opinion to Claims 2 and 20 only, in its Judgment filed on April 29, 1964, it held all of the twenty-four claims of the patent in suit invalid.

Petitioner's trial attorney did not receive a copy or have knowledge of the entry of a judgment until approximately fourteen days after it was entered, but in view of the fact that the trial court had limited its opinion to claims 2 and 20 only and had thereafter in the opinion used the term "patent" loosely, without limiting it to the two claims in issue, (R 54a lines 1, 10; R 58a lines 25, 27) corresponded with the court, requesting it to make its Opinion more consistent.

Because of Petitioner's request, the court on or about May 12, 1964 removed page 2 from its original Opinion filed on April 27, 1964 and substituted a new page 2 wherein it was there stated that "the patent here in suit is invalid" (R 52a) in lieu of its original statement that "the patent claims here in suit are invalid" (Rear of Petition). The

Court further altered page 2 of its original opinion which originally read "the patent claims of Jacobson in issue are as follows" followed by the quotation of Claims 2 and 20, by changing the language to read "the patent claims of Jacobson assertedly infringed are as follows" leaving the two claims as quoted. No other change was made, but it now superficially appeared that the opinion was directed to the entire patent.

The U.S.P.Q. evidently obtained a copy of the original opinion, for in its Advance Sheets of May 18, 1964 it reproduced the Opinion of the trial Court as originally filed. A reproduction of page 431 of these advance sheets is inserted in the rear of this Petition for it is not in the record and is found in no other report.

On February 12, 1964 the court also filed a "Memorandum Supplementing Opinion filed on April 27, 1964". This supplemental opinion included no new findings of fact but was simply an argument by the court attempting to justify its Judgment entered on April 29, 1964.

The Court of Appeals on January 7, 1966 affirmed the District Court, stating that a review of the record indicates that the validity of the entire patent and not merely Claims 2 and 20 was in issue. The Court also stated that there was evidence from which the District Judge could and did declare the entire patent invalid. The Court then stated: "We think his findings of fact were adequate and were supported by substantial evidence" (Rear of Petition). The Court then stated:

> "We find nothing improper in the trial Judge making a few changes in his opinion after it was filed, *when minor inaccuracies were called to his attention.*"* (Rear of Petition)

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* Emphasis, wherever found in this petition is Petitioner's.

Petitioner filed a Petition for Rehearing and the same was denied without opinion, on February 3, 1966.

The judgment of the Court of Appeals was entered on January 7, 1966.

ARGUMENT

Petitioner is not contesting the lower courts' decisions holding Claims 2 and 20 of the patent in suit invalid and not infringed. Neither is Petitioner making an issue of the propriety of the trial court's actions in altering the originally filed opinion.

Petitioner is simply requesting this Court to protect petitioner's property rights in the other more limited twenty-two claims which were not considered in the trial of this case nor in the opinion of the court but which were held invalid in the judgment.

THE FIRST QUESTION INVOLVED

> **"1. Should the trial court, in a suit requesting a declaratory judgment of invalidity of a patent having twenty-four claims, have passed judgment on all of the claims when, during the trial, by understanding, acquiescence and agreement between counsel and the court, the issues were limited to and the case was tried on Claims 2 and 20 only which were the claims alleged to have been infringed?"**

Petitioner admits that the original pleadings placed the entire patent in issue and if the issues had not been limited to two claims it would have been the trial court's duty to have passed on all of the claims. However, the courts recognize that even though the pleadings do place all of the claims of a patent in issue, yet by consent and agreement the issues may be limited to a lesser number of claims and the judgment should affect those claims only.

In *United Shoe Machinery Corp. v. Industrial Shoe Machinery,* 335 Fed. 2d 577 (C.A. 1, 1964) that Court had a similar situation as is here. In modifying the trial court's judgment holding all of the patent claims invalid, the Court stated:

> "We hold however that the Court should not have determined invalid claims 1-6. This is not because the Court did not have power to do so under the pleadings, see *Hap Corporation v. Heyman Manf. Co.,* op. ct. *supra* but because Industrial affirmatively told the Court that these claims were not in the case. As to them the judgment should be silent" (p. 581).

The Court of Appeals for the Sixth Circuit has made the same holding several times. Thus in the case of *Goodwin v. Carloss Co. et al.,* 116 F. 2d 644 (1941), that Court stated:

> "The District Court found the entire patent invalid, but, as Claim No. 1 was the only claim in issue, the decree will be modified to the extent that Claim No. 1 only is held invalid, and as so modified is affirmed."

In the case of *Bain v. M. A. Hanna Company,* 331 F. 2d 974, (CA 6, 1964) the trial court, in its judgment, found all of the claims of the patent in suit invalid. The Appeal Court, in modifying that order, stated:

> "Inasmuch as there are twelve claims in the patent which were not litigated (4 to 15), the language of the Court's Order 'that all claims of the patent in suit are invalid,' insofar as it may be construed to apply to claims other than Claims 1, 2 and 3, will be modified so as to be applicable to the three claims in suit only and said Order as so modified is affirmed. This Court has employed such modification procedure on a prior occasion in the patent

case of *Goodwin v. Carloss,* 116 F. 2d 644 (C.A. 6, 1941). See the last paragraph therein."

The Court of Appeals for the Sixth Circuit, on January 5, 1966, rendered its most recent opinion in *Popcorn-In-Oil Council, Inc. v. Wyndall's,* Adv. Shts., 148 U.S.P.Q. 174. The Court cited the *Popcorn case* in its Opinion in the case at bar in an effort to distinguish it, but failed to do so. The only two differences between the Popcorn case and the case at bar are: first, the suit was commenced as an infringement suit and defendant counterclaimed for a declaratory judgment to hold the entire patent invalid, which is just the reverse of the case at bar, and second, the parties in the *Popcorn case* formally stipulated at the beginning of trial to limit the issues to two claims only, rather than during the trial as was done in the case at bar.

In the *Popcorn case* the court held:

> "As we have noted, the District Judge held the Martin patent invalid both because of lack of novelty (anticipation by prior use—35 U.S.C. Sec. 102) and lack of invention (obviousness to others in the art—35 U.S.C. Sec. 103). *Limiting our decision to the two disputed claims* of the Martin patent, we affirm on the second ground cited."
>
> • • • • •
>
> "We therefore agree that claims one and four of the Martin patent (*not the patent as a whole*—see *Felburn v. New York Central Railroad Co.,* 350 F. 2d 416 (C.A. 6, 1965)) are invalid because they do not meet the test of invention and the definition thereof in 35 U.S.C. Sec. 103."

Petitioner asserts that the record in the case at bar discloses that from the very beginning of the trial there was a tacit understanding and acquiescence that only Claims 2 and 20, which were the claims alleged to have been in-

fringed, were in issue and, in at least one instance, this was agreed to by both counsel and the Court. In reviewing the record, this Court should note that Mr. Morriss is Petitioner's attorney while Mr. Kraus is Respondent's attorney.

At record pages 134a-135a Mr. Kraus was discussing some statements made in the Jacobson prosecution file concerning the Hunt prior art patent and comparing it with plaintiff's device.

> "Q. Does the Nelmor unit use springs around the end of the cable and away from the pivot point?
> A. That is our construction.
>
> • • • • •
>
> Mr. Morriss: *Max, is that statement you just read in connection with one of the claims in issue?*
> Mr. Kraus: *Yes. All I am saying is the statement that they made with respect to the Hunt patent,* (115) *regardless of whether it is Claim 2 or 20, you described the Hunt patent, and I read the statement of what you said. I am not saying it has reference to the 20 and 2;* I am saying you said in Hunt the cables had springs, and they were away from the center of the pivot point, and that is all you did and that is all I am stating it for."

At record pages 139a-140a Mr. Kraus was discussing an early model made by Petitioner which used no springs. Counsel for both parties agreed that only claims 2 and 20 were in suit:

> "The Court: I know, but this does not embody all the claims of the patent in suit; it does not involve the claims of the spring tension?
> Mr. Kraus: No, the patent says resilient tension; it does not say 'springs.' *In both claims in suit the words that are used are 'resilient tensioning*

means.' It does not say 'springs.' Therefore, anything that is resilient, even the wire itself is a resilient tensioning means according to their own definition. That is the point I am trying to make. But this comes within the theory of their claim, resilient tensioning means, and therefore, the prior art directly anticipates it, because the prior art shows cables which are resilient tensioning means, but we have this Hunt patent, and the others, which show springs anyway, but we wanted to show how far they were stretching their patent.

The Court: *There is nothing in the claim of the patent in suit that refers to springs?*

Mr. Kraus: None at all, just the words 'resilient tensioning means'; and the word 'resilient', as they apply it (124), could mean a stretched cable in and of itself without a spring. *The word 'spring' is not used in any of the claims in suit.*

The Court: Do you mind if I ask Mr. Morriss if he disagrees with what you have said?

Mr. Morriss: *Your Honor, I agree with what was just said, and I would point out that the claims 2 and 20 in issue go to a combination of elements.*

In other words, I believe that Mr. Kraus is leading the Court to an out-of-context the importance of just tensioning; while just tensioning is the inventive concept, it is an inventive concept embodying other elements.

Now, the other elements are all arranged in that model there substantially in accord with the scope that we claim for claims 2 and 20. In other words, we believe that claims 2 and 20 can be read on that device right before you."

Both Morriss and Kraus were referring to the "claims in issue" or "claims in suit". While the word "patent" is used by the court in the quotation it refers to Claims 2 and 20 only, for neither Claims 2 nor 20 recite a "spring" while other of the claims such as Claims 4, 9, 11, 12 and 24 do.

Record 146a carries a statement by Mr. Morris which was accepted by Mr. Kraus, without comment, as follows:

> "Mr. Morriss: Claims 2 and 20, which are the broadest of the twenty-three claims in our application. *Bear in mind only two claims we consider to be in issue in this cause.*
>
> The Court: That is the claims with respect to the tension device?"

At page 152a Mr. Kraus, respondent's attorney affirmatively asserts that there are only two claims in issue as follows:

> "Mr. Kraus: *Now, the point I think I made, and I think your Honor has clearly understood it, is the two claims in issue call for resilient means for tensioning* (144) *the cable.* Now, what is that resilient means? It is nothing more than the cable itself. The wire itself when stretched becomes the resilient means."

At 185a this colloquy between counsel points up that there are only the two claims in issue:

> "Mr. Kraus: You are talking about Claim 25 now. It is not Claim 2 that you are examining the witness on?
>
> Mr. Morriss: Exactly. You will find it is related to the Claim 3. *This statement is made to clarify the position of both Claims 25 and 3, which ultimately issued as Claim 2 and Claim 20, which we have before us in issue today."*
>
> • • • • •
>
> "And, I think this is very pertinent, and I would like to point out to the Court that Claim 25 mentioned in this reading, your Honor, and Claim 3, ultimately issued *as Claims 2 and 20, the claims now in issue before us.*

> Mr. Kraus: *Will you agree that the entire statement that you read had reference to Claim 25 only, and Claim 25 is Claim 20, and that isn't the subject matter that he was being interrogated on? He was being interrogated on Claim 2. But, he has read now remarks made in reference to the other claim in issue."*

At page 231a Mr. Morriss makes the following statement without objection from Mr. Kraus:

> "Mr. Morriss: No; the only application, or *the only patent, your Honor, that is in issue, is United States Leters Patent 2,931,245, and Claims 2 and 20 thereof."*

At page 239a, Mr. Morriss again calls attention that claims 2 and 20 only are in issue and Mr. Kraus does not dispute the fact:

> "Mr. Morriss; There is another remark I would like to introduce in respect to this. *The matters in issue here are the questions of what claims 2 and 20 express;* not with regard to what the commercial —not with regard to a commercial embodiment comparison of these two."

The disclosure of the patent in suit was being discussed and, without objection from Mr. Kraus, Mr. Morriss at page 260a made this statement:

> "Mr. Morriss: —and I am not asking for a construction of the claim from the witness. I am asking for a simple question, do you see a statement in here that refers to a slidable pin under any circumstances, in Claims 2 and 20?"

Again at page 288a without any objection to the statement, Mr. Morriss asked the witness the following question:

"Q. Mr. Rice, *do you find as a consequence of looking at all of the art considered and before this Court, that the* (372) *principle involved in the Claims 2 and 20 of the patent in issue is shown by any of the prior art?*"

At pages 328a-330a, a positive agreement to limit the issues to claims 2 and 20 was made.

"Q. (By Mr. Morriss, continuing): I would like to turn to page 100 of the file history—no, *I am going to skip 100, because that deals with Claim 30, which is not at issue in this application.*

Mr. Rice, for the purposes of the Court, subsequently this application was allowed and the United States Letters Patent 2,931,245 issued containing the claims 2 and 20, as reviewed in this Court, so I think we can now depart from that phase of this examination.

Mr. Kraus: Before you do, I would like to read the page that was skipped, page 100 and this is what he says, the Jervis' attorney says about the Hunt patent:

'Hunt disclosure of multiple springs each spaced from the center of pivoting and each concentric with the control wire.'

What does that mean, sir?

Mr. Morriss: Max, read the whole thing there; I think you are leaving out the preamble part, which reads:

'For this purpose, Applicant has drafted (436) and herewith submits Claim 30.'

Mr. Kraus: *That is right, this is another claim.*

Mr. Morriss: *And he is now talking about different things than what we are talking about in Claims 2 and 20. I would point out to the Court that I would object to this inquiry from this point of view; other claims in the United States Letters*

Patent 2,931,245 deal with other features, not in issue before this Court in the two subdivisions.

The Court: *Do you agree with that?*

Mr. Kraus: *I agree,* except that this is a statement as to what the Hunt patent discloses, and Hunt doesn't change its disclosure from claim to claim. Whatever Hunt shows with respect to Claim 20 [30], is still the same disclosure.

The Court: Read that again.

Mr. Kraus: 'Hunt disclosure'—that is the Hunt patent discloses—'of multiple springs each spaced from the center of pivoting and each concentric with the control wire.'

The Court: I get it; go ahead.

Mr. Kraus: That is it. All I am trying to bring forth is that the Jervis' attorney recognized that the springs in Hunt were at the end of the cables, and away from the center point.

In other words, this (indicating) being the center (437) point (indicating), this is the pivot point, that the cables are connected to the mirror, and that the springs are around the cables away from the pivot point, and that is the distinction that was being made, and that is all I am trying to show.

Mr. Morriss: We do not quarrel with that, your Honor. What we do quarrel with is that—*I thought that Mr. Kraus is going to bring in something in connection with Claim 30, which is not in issue.*"

Petitioner submits that the above colloquy between the Court and Counsel for both parties is a complete agreement that claims 2 and 20 were the only claims being litigated. It should have the same status in limiting the issues to Claims 2 and 20 as did the stipulation in the *Popcorn case.*

Page 441a further indicates that claims 2 and 20 only were in issue by this quotation:

"Mr. Morriss: *Your Honor, I would like to object to the continual reference to the frictional aspects of this structure, when indeed we have made it quite clear that there are no frictional, independent frictional means in the Claims 2 and 20.*

The Court: I know, but he does not agree with you.

Mr. Kraus: Will your device work without friction?

The Court: This is not argument. You offered proofs, which point, as you say, to the fact that Mr. Kraus is talking about now is not covered by your Claims 2 or 20. Mr. Kraus disagrees with you. He is now presenting his point of view. What is wrong with that?

Mr. Morriss: Well, I think it is irrelevant in the sense that the real issue involved here are the elements of the claims. Now, there is no—

The Court: *I know, but the elements in the claims referred to tension devices, resiliency, and other things, that Mr. Kraus is now showing that these prior patents* (619) *equate with Claims 20 and 2. Hasn't he a right to do that?*

Mr. Morriss: Sure, he has a right to do it."

Page 463a clearly indicates that the claims involved were claims 2 and 20 only:

"Mr. Morriss:

Q. Are there other claims—listen to the question again—are there other claims in United States Letters Patent 2,931,245, in which additional elements are found which would, one, specifically locate springs; or, two, which would involve sliding pins; or, three, which would involve the specific resiliency found in the commercial embodiment?

Now I am speaking of the other claims not in issue before this Court.

A. And are such elements found in those other claims?

Q. In those other claims.

A. Yes, sir."

Thus it is seen that throughout the entire record counsel for both parties as well as the court considered claims 2 and 20 to be the only claims in issue.

In view of the above, this Court should grant this petition so that the judgment be limited to claims 2 and 20 only.

THE SECOND QUESTION INVOLVED

"2. Does the trial court's original opinion, filed in lieu of findings of fact and conclusions of law and specifically directed to claims 2 and 20 only, support a judgment holding all twenty-four claims of the patent 'invalid, void and lacking in invention over the prior art.'"?

Petitioner asserts that the trial court's original opinion, filed April 27th, 1964 dealt with claims 2 and 20 only and could not support a judgment holding all 24 claims invalid.

The Jacobson patent relates to a rear view mirror which is remotely controlled by a member either on the dashboard or the inside of the door. For the purpose of this petition a detailed description of the device is not necessary.

Claims 2 and 20 are quoted in the trial court's opinion (R 53a). These claims provide for the following broad elements:

(a) a control member and controlled member remote from one another each being mounted for movement about a pivot point;

(b) three cables having one set of ends secured to the controlled member at points spaced from each other and from the pivot point and the other set of ends secured to the control member in the same

manner, for pivotally supporting said members for movement about their respective pivot points, and

(c) resilient means for applying a force coincident with one of the pivot points so that the cables at all times and in all positions will be under substantially equal tension.

The trial court, when drafting its original opinion, realized that the parties, by acquiescence and agreement, had limited the issues to the validity of claims 2 and 20 only for after a few preliminary remarks, the court set forth its opinions as to each issue. The first point of the court's conclusions reads:

> "I. that *the patent claims here in suit* are invalid for want of novelty and inventiveness." (Emphasis supplied.) (See rear of Petition.)

Then a few lines later, the court said:

> "*The patent claims of Jacobson in issue* (see drawings) are as follows:" (Emphasis supplied.) (See rear of Petition.)

Immediately thereafter the court quoted claims 2 and 20 (R 53a). The court at the top of R 54a then stated what the novel features were in these words:

> "The alleged novel feature of the patented device is the tightening of the cables or wires by the use of coil springs so as to keep each in a state of equal tension. *These springs are referred to in the patent as "resilient means".* The maintenance of equal tension upon all cables, defendant asserts is novel because it renders the device completely 'stable'. A stable device lacks any tendency in

itself to move from the position in which it is placed".

The court used the word "patent' 'in the quotation, when it stated that "these springs are referred to in the patent as resilient means," but it used the word loosely, for "resilient means" is the expression used in claims 2 and 20 while in many of the other claims different language is used, including the word "springs".

The court later on discusses the several patents in the prior art. In this discussion, the court continually finds or does not find "resilient means" in these patents. He points out how each prior art patent does or does not have the three broad elements of claims 2 and 20 as set forth above. He does not discuss any of the other more limited elements found in the other twenty-two claims.

When discussing Chantraine, he sets forth the three broad elements of claims 2 and 20, and then says that Chantraine has no "resilient means." He discusses Hoffman to show an improvement over Chantraine.

He then discusses the British patent to Hunt and applies its disclosure to every element found in claim 2 (R 57a).

After some more discussion the court then stated: "• • • it must be concluded that the patent in suit is invalid for want of inventiveness" (R 59a).

Here again the court used the word "patent" loosely for as pointed out above he was considering claims 2 and 20 only in the opinion and had not in any manner whatsoever discussed the other more limited 22 claims, which include as elements the very details that make Petitioner's rear view mirror the success that it was and is.

As the judgment filed April 29th 1964 (R 63a) stated in its preamble that it was based on the court's opinion of

April 27th, it is obvious that the judgment, holding all of the claims of the patent invalid, is not supported by the findings in the opinion. Petitioner submits that this Honorable court should issue its writ of certiorari to correct this obvious departure from normal procedure, and return to petitioner the 22 claims which were not in issue.

THE THIRD QUESTION INVOLVED

"3. Does the trial court's opinion, altered twelve days after the judgment was entered, by removing page 2 from the filed opinion and inserting a new page therefor to make it superficially appear that the original opinion was directed to all of the patent claims, together with the trial court's supplemental opinion filed on February 12th, 1964, support the judgment holding all of the patent claims 'invalid void and lacking in invention over the prior art' when no additional findings of fact were made."?

After Petitioner's counsel requested the court to revise its opinion to make it consistent with the court's findings, as above discussed, the court removed page 2 from its filed opinion and substituted therefor a new page two. Where the original opinion stated:

> "I. that *the patent claims herein suit* are invalid * * *" (Rear of Petition)

the court altered it to read:

> "I. that *the patent here in suit* is invalid * * *." (R 52a)

Further along, where the original opinion stated:

> *"The patent claims of Jacobson in issue * * * are as follows:* (Rear of Petition)

the court altered this to read:

> *"The patent claims of Jacobson assertedly infringed * * * are as follows:* (R 52a)

Not a single finding of fact was changed in the original opinion, nor was any additional facts added. Petitioner therefore asserts that the two changes in the original opinion were superficial and did not change the basic fact that the opinion was dealing with claims 2 and 20 only and not with the entire patent. However the changes, though superficial, would lead a casual reader of the altered opinion to assume that the court's opinion had, at all times, been directed to all of the claims of the patent, even though the opinion is barren of any findings relating to any claims other than claims 2 and 20.

Even the Headnote editor of U.S.P.Q. was misled by these superficial changes. When the original opinion was reported in the advanced sheets, his last headnote read:

> "2,931,245, Jacobson, Remote Control Rear View Mirror, *claims 2 and 20 invalid and not infringed.*" (Rear of Petition.)

After the opinion was altered and when the permanent volume of USPQ was published the last headnote now read:

> "2,931,245, Jacobson, Remote Control Device, Particularly for an Automotive Rearview Mirror, invalid and not infringed" (141 USPQ 431).

This court needs no authority to support the elementary rule that the conclusions of law, as well as the judgment, must be supported by findings of fact. The courts below have failed to follow this elementary rule, and hence this petition.

On the same day that the court removed page two from its originally filed opinion and inserted the new page, it also filed its "Memorandum Supplementing Opinion filed on April 27th, 1964" (R 64a). This Memorandum is silent

concerning the alteration that the court had made in the original opinion. It does not include a single additional finding of fact. It simply calls attention to certain pages of the record, which the court states is evidence that all of the claims of the patent were being litigated.

When these references are considered, it is obvious that they do not support the court's "argument" in any manner whatsoever. During the trial, when the patent was being described or when the accused device was being differentiated from Petitioner's device or from the disclosure of the patent, certain details, which are found as elements in the other 22 claims were referred to and their functions discussed. It is this type of reference that the court refers to in its supplemental opinion as supporting his contention that all of the claims were litigated. Many of the record references cited by the court expressly refute its contention, for a reading of the reference pages in their entirety will show that insofar as validity is concerned, only claims 2 and 20 were involved.

As stated above, there is no prior art of any nature whatsoever that relates to any part of Jacobson's inventions except those broad elements as set forth in claims 2 and 20. It would thus appear that even though the trial court in its altered opinion and judgment found that all of the patent claims were invalid, there is nothing in the record, and certainly nothing in the opinions upon which these conclusions could be based. Petitioner therefore asserts that the 22 claims not in issue have been held invalid, not because the record shows that they are, but because the trial court mistakenly believed that he had to decide the validity of the entire patent in view of the pleadings (forgetting entirely about the agreement of the parties to limit the trial to the two claims only).

CONCLUSION

This case presents an ideal situation wherein this Honorable Court should exercise its power of supervision over the lower courts, because of their departure from the accepted and usual course of judicial proceedings. It is submitted that a writ of certiorari should be issued so that this Court may outline to the lower courts, what is the accepted and usual course of judicial proceeding which should be followed not only in the case at bar, but in all similar cases.

Respectfully submitted,

CLARENCE B. ZEWADSKI,
3053 Penobscot Building,
Detroit, Michigan,
Attorney for Petitioner.

February 25, 1966.

District Court, E. D. Michigan, S. Div.

NELMOR CORPORATION V. JERVIS CORPORATION

No. 22655 Decided Apr. 27, 1964

PATENTS

1. Construction of specification and claims—Broad or narrow—Improvement patents (§ 22.103)

In a heavily occupied art, scope of new patent must be narrowly limited to structure described in specification and depicted in drawings.

TRADEMARKS

2. Infringement—In general (§ 67.431)

UNFAIR COMPETITION

Appearance of goods or labels—In general (§ 68.201)

Defendant's trademark appears on inside of housings for its mirrors; plaintiff placed its own mirror and components of its device in ten such housings for purpose of exhibiting its product to automobile manufacturers; in making these models and demonstrating its devices, plaintiff was not guilty of trademark infringement and unfair competition since plaintiff actively promoted its product as being better than and different from defendant's; therefore, there was no possibility of confusion as to source of products.

PATENTS

3. Costs—Attorney's fees (§ 25.5)

Although defendant's disclosure to Patent Office in prosecution of its patent was erroneous, there was no showing of bad faith; hence, on finding patent invalid, court refuses attorneys' fees to plaintiff.

Particular patents—Mirror

2,931,245, Jacobson, Remote Control Rear View Mirror, claims 2 and 20 invalid and not infringed.

Action by Nelmor Corporation against Jervis Corporation for declaratory judgment of patent invalidity and noninfringement in which defendant counterclaims for patent and trademark infringement and unfair competition. Judgment for plaintiff.

RICHARD P. BARNARD, Birmingham, Mich. (MAX R. KRAUS, Chicago, Ill., of counsel) for plaintiff.

WILLIAM J. MORRISS, Lansing, Mich., for defendant.

LEVIN, Chief Judge.

Plaintiff, Nelmor Corporation, an Illinois corporation having its principal place of business in Michigan, seeks declaratory judgment pursuant to 28 U.S.C. §§ 2201, 2202, against Jervis Corporation, a Michigan corporation, holding that defendant's patent No. 2,931,245, (assigned to defendant by Edwin B. Jacobson and hereinafter referred to as the Jacobson patent) is invalid and, additionally, that plaintiff has not infringed this patent.

Plaintiff, a manufacturer and vendor of remote control rear view mirrors for automotive vehicles, alleges interference with its trade because the defendant threatened plaintiff's customers with suit for infringement of the Jacobson patent.

The defendant's answer requests a declaration that the patent is valid, a holding of infringement of Claims 2 and 20 of the Jacobson patent and of defendant's trademark, No. 601,519, and that plaintiff engaged in acts of unfair competition. Jurisdiction of this last claim exists under 28 U.S.C. § 1338.

The court had the benefit of expert testimony from persons familiar with the art, models of devices manufactured and sold by the parties, models made under the prior art, comprehensive briefs before and after trial, and oral argument of counsel.

It is the opinion of this court: I. that the patent claims here in suit are invalid for want of novelty and inventiveness;[1] II. that even if the patent were valid there has been no infgringement; and III. that plaintiff has neither infringed defendant's trademark nor engaged in acts of unfair competition.

The products of both plaintiff and defendant are commonly seen in automobiles, wherein a handle is located on the dashboard or inside of the door and a mirror is located on the left front fender or on the outside of the left front door. In the patented device, as well as that marketed by plaintiff, a handle is attached to a control member which rests in a socket, and the mirror is held against a single pivot, shaped as a ball, which allows universal movement. Three cables connect the control member to the mirror in such a manner that when the handle is manipulated corresponding movement is imparted to the rear view mirror.

The patent claims of Jacobson in issue (see drawings) are as follows:

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[1] If a recitation is required at this late date of the elements requisite to the validity of a patent, see Harvey v. Levine, 322 F.2d 461, 138 USPQ 639 (6th Cir. 1963), and cases there cited.

OPINION OF COURT OF APPEALS

(Filed January 7, 1966)

No. 16,084

United States Court of Appeals for the Sixth Circuit

NELMOR CORPORATION, *Plaintiff-Appellee,* v. JERVIS CORPORATION, *Defendant-Appellant.*	APPEAL from the United States District Court for the Eastern District of Michigan, Southern Division.

Decided January 7, 1966.

Before WEICK, Chief Judge, EDWARDS, Circuit Judge, and CONNELL,* District Judge.

WEICK, Chief Judge. This case involves questions concerning the validity and infringement of Jacobson Patent No. 2,931,235 on a remote control rearview mirror commonly used on automobiles. The patent was assigned by the inventor to Jervis Corporation.

Nelmor Corporation, an alleged infringer, brought action in the District Court against Jervis for declaratory

* Honorable James C. Connell, Chief Judge United States District Court, for the Northern District of Ohio, sitting by designation.

judgment that the patent was invalid and not infringed. Jervis counterclaimed for infringement of claims 2 and 20 of the patent and also for infringement of trademark and unfair competition.

Trial upon the merits was had in the District Court. Experts testified for each of the parties. Models of the patented, accused, and certain prior art devices were offered in evidence. The file wrapper from the Patent Office was also before the Court.

After hearing and considering the evidence, arguments and briefs of counsel the District Judge, in a well considered opinion which he adopted as findings of fact and conclusions of law, held that the entire patent was invalid for want of invention over the prior art and was directly anticipated element for element and function for function thereby. The Court further found that claims 2 and 20 of the patent were not infringed by Nelmor. The Court also found no infringement of trademark or unfair competition. The opinion of the District Court is reported in 229 F.Supp. 864, and a supplemental opinion in 229 F.Supp. 871.

Jervis has appealed only from the judgment of the Court holding the patent invalid and not infringed.

Both Jervis and Nelmor are suppliers of rearview mirrors to the automotive industry. The mirror is attached to either the left front fender or door of the car, and a handle with which the mirror is controlled or manipulated is located on the dashboard or inside the left door.

The District Court found utility and commercial success in the patented device from the fact that Jervis had produced and sold over two million mirrors under the Jacobson Patent.

The devices were described by the District Judge as follows:

> "In the patented device, as well as that marketed by plaintiff, a handle is attached to a control member

> which rests in a socket, and the mirror [controlled member] is held against a single pivot, shaped as a ball, which allows universal movement. Three cables connect the control member to the mirror in such a manner that when the handle is manipulated corresponding movement is imparted to the rearview mirror . . .
>
> "The alleged novel feature of the patented device is the tightening of the cables or wires by the use of coil springs so as to keep each in a state of equal tension. These springs are referred to in the patent as 'resilient means'. The maintenance of equal tension upon all cables, defendant asserts, is novel because it renders the device completely 'stable'. A stable device lacks any tendency in itself to move from the position in which . . . [it] is placed."

The resilient means in the patented device is one coil spring around a so-called sliding pin which connects the handle to the mirror. It is positioned at the pivot point (mirror) and located in the center of the three cables. The coil spring pushes the pin outward and thereby imparts tension to the cables.

In Nelmor's device the mirror pivots on a stationary, rather than a sliding, pin. No springs are used on the pin. Tensioning of the cables is accomplished by placing a coil spring around each of the three cables at the end of the control member (handle). These springs pull the cables inward in the direction of the mirror.

It was not disputed that the elements or parts comprising the patented device were all old and found in the prior art. The District Judge determined that the amalgamation of the old parts was a mere aggregation which accomplished no new purpose or function. *Lincoln Enginering Co.* v. *Stewart-Warner Corp.*, 303 U.S. 545 (1938). He cited two patents which were not considered by the Patent Office, Chantraine, No. 387,930 (France) and Hoffman, No. 650,368 (Germany).

Chantraine dated back to 1908 and was a cable-operated remote controlled device designed for "universal movement." It used a ball and socket arrangement to hold the controlled member in place. The controlled member rested in the socket and was connected to the control member (handle) by a plurality of cables spaced from each other. It was necessary to maintain the cables in a tightened position, which was accomplished by stretching them on a fixed pulley. No springs were used in this patent but the cables were referred to as "stretched".

Hoffman, issued in 1937, for a remote controlled spotlight, was not cited by the Patent Office. This patent utilized the ball and socket structure of *Chantraine,* but had only three cables. Tension was maintained by stretching the cables. No resilient means other than the stretching were used.

The most pertinent patent, however, was before the Patent Office, namely, *Hunt,* No. 433112 (British) issued in 1935. This patent was for improvements in automotive headlamps. The control and controlled members were connected by three cables maintained under tension by coil springs which encircled them at their ends and were adjacent to the controlled member (mirror). The District Court found that every element of claim 2 of Jacobson is contained in *Hunt.*

The Patent Office twice rejected Jacobson's application for patent on the ground that his device was unpatentable over *Hunt.* The Examiner was finally persuaded to allow the patent because of the claim then advanced that Hunt's device was unstable and not suitable for a rearview mirror. Jervis maintained this position until the last day of the trial of the case at bar when it was otherwise demonstrated by the use of a model. Jervis' expert witness finally admitted upon cross-examination that the spring 56 located at the center of the controlled member in *Hunt* could be adjusted so as to render the device stable in all positions. This demonstration and admission, in our judgment, was the turning point of the trial. It is very doubtful that the

Patent Office would ever have issued the patent had it known that the claims of instability of *Hunt*, advanced by Jacobson, were incorrect.

Jervis distinguishes *Hunt* because of differences in the structure of the two devices. It points out that although *Hunt* has three cables, only two of them are used for moving the lamp, and the third one for focusing the bulb in the lamp. The trouble with this contention is that all three cables were connected to the front end of the reflector and at the rear end to the handle. If a rearview mirror were substituted in the place of the lamp, the operation would be the same. Furthermore, *Hoffman* disclosed three cables utilized for universal movement so that Jacobson's use of three cables was not new.

The location of a single spring in *Jacobson* at the center of the pivot, in contrast to *Hunt* where springs were positioned away from center, does not, in our judgment, constitute invention. All three spring-tensioned cables in *Hunt* connect the control member (handle) with the controlled member (reflector) which may be adjusted and maintained stable in any universal position. The spring 56 tends to stabilize the *Hunt* device.

The fact that the patented device had utility and commercial success, while important in a doubtful case, does not entitle an inventor to a patent where invention is lacking. *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Co.*, 340 U.S. 147 (1950); *Harvey* v. *Levine*, 322 F.2d 481 (6th Cir. 1963).

Jervis contends that the findings adopted by the District Court were insufficient to support the judgment declaring the entire patent invalid. It maintains that the evidence at the trial was directed only to claims 2 and 20 of the patent and not to the entire patent. It points out that shortly after the original opinion was filed the District Judge substituted a new page 2 therein.

A review of the record indicates that the validity of the entire patent, and not merely claims 2 and 20, was in issue.

This is unlike *Popcorn-in-Oil Council, Inc.* v. *Wyndall's Super Market, Inc.*, — F.2d — (C.A. 6, 1966), decided January 5, 1966, where only two claims, and not the entire patent, were in issue. Although the evidence in the present case was directed principally to claims 2 and 20 and to the issue of infringement, there was also evidence from which the District Judge could and did declare the entire patent invalid. We think his findings of fact were adequate and were supported by substantial evidence. They were not clearly erroneous and hence are binding on us. *Maytag Co.* v. *Murray Corp.*, 318 F.2d 79 (6th Cir. 1963). His conclusions of law were correct. We find nothing improper in the trial Judge making a few changes in his opinion after it was filed, when minor inaccuracies were called to his attention. Copies of the substituted page were immediately sent to all counsel of record.

The District Court found that claims 2 and 20 of the patented device were not infringed by Nelmor's device. This Court in *Maytag Co.* v. *Murray Corp., supra,* at page 83, stated:

> "The question of infringement is generally regarded as a question of fact. *Hamilton Mfg. Corp.* v. *Toledo Guild Products,* 210 F.2d 237, 238, C.A. 6; *Aluminum Co. of America* v. *Thompson Products, Inc.,* 122 F.2d 796, 799, C.A. 6. Accordingly, upon review of the trial court's determination of no infringement, the clearly erroneous rule, Rule 52(a), F.R.C.P., is applicable."

The District Court found that the basic difference between the patented and accused devices was in the location of the resilient means. The patented device has one centrally located spring, while Nelmor's device utilizes springs located at the end of each of the three cables. Jervis argues that the patent in suit covers the location of springs at the ends of the cables as the description in the patent only requires the force to be located on the pivot point, not that the spring be so located. Jervis in essence con-

tends that neither claim, 2 or 20, specifies the location of the resilient means.

The Jacobson patent was in a heavily occupied field. The claims of a patent in a crowded art must be restricted to the specific structure described in the specifications and drawings. *Cincinnati Milling Machine* v. *Turchan,* 208 F.2d 222 (6th Cir. 1953).

When the two structures are compared it cannot be said that the District Court's findings with respect to infringement were unreasonable and not supported by the evidence

Affirmed.

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No. 1070

In the

Supreme Court of the United States

OCTOBER TERM, 1965.

NELMOR CORPORATION,

Plaintiff-Respondent,

vs.

JERVIS CORPORATION,

Defendant-Petitioner.

On Petition For A Writ Of Certiorari To The United States Circuit Court Of Appeals For The Sixth Circuit.

BRIEF FOR RESPONDENT IN OPPOSITION

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1965.

No.

NELMOR CORPORATION,

Plaintiff-Respondent,

vs.

JERVIS CORPORATION,

Defendant-Petitioner.

On Petition For A Writ Of Certiorari To The United States Circuit Court Of Appeals For The Sixth Circuit.

BRIEF FOR RESPONDENT IN OPPOSITION

The Respondent, Nelmor Corporation, was plaintiff and appellee in the courts below.

STATEMENT OF THE CASE

The Jacobson patent in suit No. 2,931,245, owned by Petitioner, Jervis Corporation, relates to a mechanically operated rear view mirror for automobiles which is mounted on a fender or door of an automobile and is adjusted from inside of the automobile through the use of three or more wires or cables which are moved by means of a control knob mounted on the dashboard. The alleged novel feature of the patented rear view mirror was the use of coil springs to keep the wires taut or tensioned. The patent contained 24 claims.

Respondent, a manufacturer of rear view mirrors for automobiles, after being charged with infringement of Petitioner's patent, filed a petition for a declaratory decree praying that the *entire patent, including all the claims thereof,* be declared invalid and that Respondent be held not to infringe said patent (R.4a-7a).

Petitioner's answer denied that the claims of the patent were invalid and void (R.9a, Par. 13, 15), and asserted by way of counterclaim that Claims 2 and 20 were infringed and prayed for "A Judgment finding U.S. Letters Patent No. 2,931,245 valid and infringed by the devices of plaintiff" (R. 11a).

Respondent's answer to the counterclaim alleged that all of the claims of U.S. Patent No. 2,931,245, and more particularly Claims 2 and 20, were invalid and void (R. 13a) and prayed that said patent, including Claims 2 and 20 be declared invalid (R. 14a). Issue was thus joined on the pleadings on *all of the claims* of the patent in suit.

The Petitioner admits that the entire patent was placed in issue by the pleadings (p. 6).

On the question of infringement, only Claims 2 and 20 were in issue and with respect to these two claims Respondent contended that:

(1) These claims were invalid because they were anticipated element for element and function for function by the prior art, and

(2) They were not infringed due to file wrapper estoppel, because during the proceedings in the Patent Office the Petitioner had so limited these claims that they excluded the rear view mirror made by the Respondent.

On the issue of invalidity, all of the remaining claims of the patent were included and Respondent asserted that:

(1) The structure and function set forth in each of the remaining claims did not involve invention over the prior art, and

(2) Petitioner had misled the Patent Office as to the structure and function of the principal prior art patent, namely, the Hunt Patent No. 433,112. Petitioner erroneously represented to the Patent Office and erroneously convinced the Patent Office that the device of the prior art Hunt patent was unstable and inoperative for the purpose intended. As a consequence of said erroneous representations by the Petitioner, the principal prior art reference was withdrawn by the Patent Office and the claims of the Jacobson patent in suit were allowed.

The Petitioner made similar assertions before the trial Court and attempted through the testimony of its expert witness to establish that the device of said principal prior art Hunt patent was unstable. However, Petitioner's expert was compelled to admit that he was in error, that the representations made to the Patent Office were in error, and that the principal prior art reference was a stable device.

The trial Court in its written opinion invalidated specifically Claims 2 and 20 of the patent in suit on the ground that these claims were anticipated by certain of the prior art patents which the Court reviewed in detail. The Court further found that the entire patent was invalid for lack of novelty and invention, and that Claims 2 and 20 were not infringed, even if the claims were valid, in view of the file wrapper estoppel.

With respect to the erroneous statements made to the Patent Office by Petitioner, the trial Court stated (R. 57a):

"The Patent Office cited Hunt in the Jacobson patent. Although defendant (Petitioner) acknowledged to the Patent Office that tensioning by use of resilient means was not novel, it sought to distinguish Hunt by claiming that the Hunt device was inherently unstable except in neutral or centered position and therefore vibration of a moving automobile would cause such device to return to center. This distinction proved erroneous on trial. Plaintiff (Respondent) introduced a physical embodiment of the Hunt patent which was operated and demonstrated to be a stable device. Moreover, defendant's expert, upon cross-examination, admitted that spring 56 at the center of the controlled member can be adjusted so as to render the device stable in all positions. *It is obvious that the testimony of the defendant to the Patent Office concerning Hunt was erroneous.*"

The Court of Appeals in affirming the District Court made the following reference to the aforementioned:

"The Patent Office twice rejected Jacobson's application for patent on the ground that his device was unpatentable over Hunt. The Examiner was finally persuaded to allow the patent because of the claim then advanced that Hunt's device was unstable and not suitable for a rearview mirror. Jervis (Petitioner) maintained this position until the last day of the trial of the case at bar when it was otherwise demonstrated by the use of a model. Jervis' expert witness finally admitted upon cross-examination that the spring 56 located at the center of the controlled member in Hunt could be adjusted so as to render the device stable in all positions. This demonstration and admission, in our judgment, was the turning point of the trial. *It is very doubtful that the Patent Office would ever have issued the patent had it known that the claims of instability of Hunt, advanced by Jacobson, were incorrect.*" (Emphasis ours)

The erroneous statements made by Petitioner to the Patent Office were made in relation to almost all of the claims of the patent in suit and were not limited merely to Claims 2 and 20.

The Petitioner is not praying to review the judgment insofar as it relates to the invalidity or non-infringement of Claims 2 and 20 (p. 1).

REPLY TO PETITIONER'S FIRST QUESTION

The Issue on Invalidity Embraced All of the Claims of the Patent and was Not Limited to Claims 2 and 20.

While the Petitioner admits that the pleadings placed all of the claims in issue, it contends that during the trial, by understanding, acquiescence and agreement between counsel and the Court, the issues were limited only to Claims 2 and 20. This contention was rejected by the trial Court and by the Court of Appeals. This contention is wholly incorrect, as evidenced by the contrary action of Petitioner during the trial and after the conclusion of the trial when Petitioner submitted findings of fact and conclusions of law to the Court for adoption, which findings were directed to sustaining the validity of the entire patent and not merely Claims 2 and 20.

The trial of the patent question consumed seven days and there is over 400 pages of printed testimony in the record. Every structural and functional detail of Petitioner's commercial device was gone into by Petitioner's and Respondent's experts at the trial. These details not only included the structural elements and functions of Claims 2 and 20, but included all of the structural elements, features and functions of each of the claims of the patent in suit.

Petitioner's attorney, Mr. William Morriss, stated at the trial (R. 152a):

> "Mr. Morriss: This patent belongs to the Jervis Corporation (Petitioner). It contains some 20-odd claims. All of those 20-odd claims, dominate or cover the Jervis unit. In other words, we could go right down the line to our narrowest claim, nuts and bolts type claim, down to the end of the line, and we would be able to read that claim on our structure, that is, the commercial structure that we produce."

The trial Court in its supplemental opinion stated (R. 65a):

> "As noted in the initial opinion, the court at trial examined and studied the device manufactured by the defendant (Petitioner) which incorporated the teachings of the entire patent."

Petitioner's expert Rice testified that Petitioner's commercial unit in evidence embodied the patent in suit (446a, 447a). Petitioner introduced considerable testimony concerning every element and function of its device, including such elements as the sliding pins, the springs around the pins which produced the tension, and the sheathing or casing around the cables. Petitioner's expert Rice, the patentee Jacobson, and Respondent's expert Warhol each testified concerning these elements and their functions (R. 70a-74a, 82a, 158a, 159a, 162a, 168a, 233a, 234a, 236a-240a, 243a, 259a, 260a, 272a, 277a, 282a, 378a, 379a, 449a-453a). The Chart (R. 61a) which is attached to the Court's opinion illustrates Petitioner's commercial unit, and includes the sliding pins and the coil springs around the pins. Petitioner's expert made a force diagram (271a, 272a) of Petitioner's device which utilized the sliding pins and the coil springs thereon.

The trial Court had the benefit of extensive testimony concerning the structure and operation of Petitioner's commercial device, and, accordingly, knew what was embraced in each and every one of the 24 claims of the patent in suit. Some claims called for "tensioning means," others called for "coil springs" as the tensioning means; some claims called for "sliding pins," others called for "casings around the cables," but each and every one of these elements was included in Petitioner's commercial device. Twenty of the 24 claims of the patent, namely, Claims 1, 3, 4, 5, 6, 7, 8, 10, 13, 14, 15, 16, 17, 18, 19, 21, 22 and 23 called for "resilient means" similar to Claims 2 and 20. The remaining four claims, namely, 9, 11, 12 and 24 specified "springs" as the "resilient means." Claim 12 alternately used the terms "springs" and resilient means" to designate the same thing. Claims 4, 9 and 19 included the sliding pin, and Claims, 1, 3-9 and 18 included the sheath or casing enclosing the cable.

The Court, basing its findings on ample evidence, was fully justified in stating in its supplemental opinion that Petitioner's device incorporated the teachings of the entire patent (R. 65a). Thus, the trial Court fully considered and evaluated each of the claims of the patent, not merely Claims 2 and 20, and held all of the 24 claims of the patent invalid.

If, as Petitioner contends, Claims 2 and 20 were the only claims in issue, then there would have no need for all of the testimony concerning the other features, such as the sliding pins, springs around the pins, and the sheathing or covering around the wires, which features are included in the other claims but are not included in Claims 2 and 20.

In order to prevail below Petitioner had to sustain the validity and infringement of Claims 2 and 20. The thrust

of Petitioner's case, therefore, was directed to Claims 2 and 20 and consequently a substantial portion of the testimony was related to the said two claims. Manifestly, this did not and could not rule out the testimony relative to the other claims of the patent which were placed in issue by the pleadings. At no time was there any understanding, acquiescence or agreement between counsel and the Court which limited the issue only to Claims 2 and 20 and ruled out any consideration of the issue of invalidity of the remaining claims. Certainly, the District Court never recognized or was aware of the existence of any such agreement or understanding, for in addition to holding Claims 2 and 20 invalid and non-infringed, it held each of the claims of the patent invalid and void. In fact, after the trial, when counsel for both sides were requested by the Court to present proposed findings and conclusions of law, Petitioner's counsel at that time, fully cognizant of what had transpired during the trial and obviously fully aware that there was no understanding or agreement to limit the issues, submitted proposed findings of fact and conclusions of law which did not limit the issue of validity merely to Claim 2 and 20 but in fact submitted proposed findings to the effect that the patent which included all of the claims was valid. The trial Court in its supplemental opinion so stated (R. 65a).

After the District Court had rendered its opinion on April 27, 1964, holding all of the claims of the patent invalid, Petitioner's attorney questioned the scope of the Court's finding of invalidity of the entire patent. On May 12, 1964 the Court filed a supplemental opinion which stated that the proofs at the trial were not limited to Claims 2 and 20 but embraced *all of the claims* of the patent. The supplemental opinion made reference to the specific pages of the typewritten record dealing with the

structure, elements and functions found in the other claims and not in Claims 2 and 20. The opinion further stated that after the trial of the case the Petitioner had submitted drafts of findings of fact in which it sought to sustain the validity of the *entire patent* and not merely Claims 2 and 20. The proposed findings submitted by Petitioner at the conclusion of the trial clearly contradicts its present position that there was an understanding, acquiescence or agreement to limit the issue to Claims 2 and 20.

Petitioner quotes several statements made by its trial attorney Mr. Morriss that Claims 2 and 20 were the only claims in issue and asserts that in one instance Respondent's attorney and the Court made a positive statement limiting the issue to Claim 2 and 20. These quotations in the Petition are incomplete and are taken out of context from the testimony which preceded and followed the quotations. In the several instances where Petitioner's attorney referred to Claims 2 and 20 as the only claims in issue, the witnesses were dealing with the question of infringement and the meaning of the language of those two claims as interpreted by the file history proceedings. These statements by Petitioner's attorney could not be binding on Respondent unless Respondent acquiesced—and there was no acquiescence, even if in fact there were an attempt by Petitioner to limit the issues to the two claims.

The single quotation reproduced on pages 13, 14 of the Petition, which Petitioner alleges was a positive agreement by counsel and the Court to limit the issues to Claims 2 and 20 does not sustain Petitioner's position. At that point in the trial Claims 2 and 20 were beng discussed and Petitioner's expert Rice was being questioned with reference to the file history proceedings in the Pat-

ent Office and whether the interpretation placed on certain language of Claims 2 and 20 by the inventor Jacobson, in view of the prior art, limited Claims 2 and 20 and hence, ruled out infringement of these claims by Respondent. This was the only question being considered at that point and Petitioner's statement that Claims 2 and 20 were the only claims had reference solely to the question of file wrapper estoppel and of infringement. No other claims were involved with file wrapper estoppel and infringement and it was correct to state that Claims 2 and 20 were the only claims on that particular issue. There is no suggestion in the above noted quotation that the remaining claims of the patent were not in issue on the question of validity. Throughout the trial each and every one of the claims of the patent was under attack. If the issues were limited to Claims 2 and 20 then why did Petitioner find it necessary to introduce testimony dealing with other structural details defined in all the other claims and not contained in Claims 2 and 20? It was abundantly clear to all counsel and to the Court that the issues were not so limited, and the Courts below so held.

The cases cited by Petitioner are not in point. In the Popcorn case there was an express stipulation between the parties at the beginning of the trial that the issues be limited to certain claims. In the other cases cited the Courts held that the parties affirmatively advised the Courts that certain claims were not in issue. The facts here are not comparable to those in the cases referred to.

In *Altvater* v. *Freeman,* 319 U.S. 359, this Court held that where a counterclaim raises the question of invalidity of the patent, the Court must decide the validity of the patent and cannot dismiss the complaint on finding non-infringement.

In *Trico Products* v. *Anderson,* 147 F(2) 721, C.C.A.7, the defendant interposed a counterclaim for declaratory judgment of invalidity and non-infringement which the District Court dismissed. The Court of Appeals held that the District Court erred in dismissing the counterclaim since the defendant was entitled to affirmative relief.

In *Allegheny Steel* v. *Elting,* 141 F(2) 148, C.C.A.7, the plaintiff filed a petition for declaratory decree to declare the patent invalid and non-infringed. The Appellate Court stated:

> "The validity of the mechanical patent was brought to issue by plaintiff's petition and it could not be eliminated by a mere amendment of appellant's answer and counterclaim. A court of equity having jurisdiction, retains such jurisdiction for all purposes, and it was not precluded from exercising that jurisdiction by withdrawal of the charge of infringement contained in appellant's answer and counterclaim."

In *Kalo Inoculent Co.* v. *Funk Bros. Seed Co.,* 161 F(2) 981, 991, C.C.A.7, plaintiff, the patent owner, brought suit for infringement of certain claims of a patent. Defendant counterclaimed seeking declaratory judgment upon all of the claims. The Appeal Court held that it was error for the District Court to pass upon only certain claims, since that did not dispose of all of the issues in controversy between the parties, which were all of the claims of the patent. (Reversed on other grounds, 333 U.S. 118).

In *Lackner Co.* v. *Quehl Sign,* 145 F.(2), 932 C.C.A.6, the Court of Appeals held that the District Court did not err in holding the patent invalid where the defendant filed a counterclaim attacking the validity of the patent and asking for a determination on validity, after the patent owner had moved to dismiss the suit with prejudice and

offered to grant the infringer a free license. The Court held that a controversy existed which had to be adjudicated and also discussed the public interest involved in the determination of the validity of a patent.

In *Kawneer Co.* v. *Pittsburgh Plate Co.*, 103 F.S. 671 D.C. W.D. Mich., S.D., the District Court made a comprehensive analysis of the law and authorities on the subject. The Court held that the charge that the defendant was infringing the patent was a general charge of infringement going to the entire patent, that the defendant could put in issue the validity of all the claims, and that the patent owner could not restrict consideration only to several of the claims of the patent.

In *Brunswick Balke* v. *American Bowling & Billiard Corp.*, 150 F(2) 69, C.C.A.2, the District Court held claim 1 of the patent not infringed and did not consider the defense of invalidity or the counterclaim of the defendant. The Court of Appeals held that the District Court erred in not considering the issue of validity of the patent since it was raised in the counterclaim and since the public interest was involved.

In *Airolite Co.* v. *Fiedler*, 147 F(2) 496, C.C.A.2, the Court of Appeals held that all of the claims should have been held invalid in accordance with the prayer of the counterclaim.

REPLY TO PETITIONER'S SECOND QUESTION

The Original Opinion Invalidated All of the Claims

The trial Court's original opinion filed April 27, 1964 dealt with all of the claims of the patent. The Court's original opinion stated that the pleadings brought the validity of the patent in issue (R. 52a). The Court stated (R. 52a):

"That even if the patent were valid there has been no infringement."

It further stated (R. 54a):

"The alleged novelty of the *patented device* is the tightening of the cable or wires by the use of coil springs so as to keep each in a state of equal tension."

and continues:

"As will be seen from an analysis of the prior art, infra, the defendant's *patent* lacks both novelty and invention."

The opinion proceeds to analyze the prior art patents on which the Court based its finding of invalidity of the patent in suit and concluded (R. 58a):

"It must be concluded that the *patent in suit* is invalid for want of inventiveness." (Emphasis ours)

The foregoing statements in the trial Court's original opinion filed on April 27, 1964 clearly invalidated the entire patent and not merely Claims 2 and 20. This opinion constituted the Court's findings of fact and conclusions of law and was very detailed and specific. It pointed out the alleged novelty of the patent and specifically where it was found in the prior art. The Court attached to its opinion (R. 62a) a copy of the drawings of the Hunt prior art patent. It also attached a chart (R. 61a) illustrating Petitioner's commercial device, which was fully discussed under the first issue herein, and which embodied all of the elements, features and functions embraced in all 24 claims of the patent in suit. These features included "springs," "sliding pivot pins," and casings around the cables," which were recited in the other claims but not in Claims 2 and 20.

On April 29, 1964, two days after the Court filed its original opinion, the Court entered its judgment, holding (R. 63a):

> "3. *All of the claims* of United States Letters Patent No. 2,931,245 are invalid, void and lacking invention over the prior art, as is required by the provisions of 35 U.S.C. §103.
>
> 4. Claims 2 and 20 of United States Letters Patent No. 2,931,245 are invalid and void as being directly anticipated, element for element and function for function, by the prior art."

The trial Court's findings in its original opinion of April 27, 1964 were detailed and specific and supported the judgment holding all 24 claims of the patent invalid.

The Court of Appeals affirmed the District Court and stated:

> "Jervis (Petitioner) contends that the findings adopted by the District Court were insufficient to support the judgment declaring the entire patent invalid. It maintains that the evidence at the trial was directed only to Claims 2 and 20 of the patent and not to the entire patent. It points out that shortly after the original opinion was filed the District Judge substituted a new page 2 therein.
>
> A review of the record indicates that the validity of the entire patent, and not merely Claims 2 and 20, was in issue. * * * Although the evidence in the present case was directed principally to Claims 2 and 20 and to the issue of infringement, there was also evidence from which the District Judge could and did declare the entire patent invalid. We think his findings of fact were adequate and were supported by substantial evidence."

REPLY TO PETITIONER'S THIRD QUESTION

The Original Opinion Supports the Judgment Holding All the Claims Invalid.

The Petitioner appears to question the propriety of the trial Court in correcting a few words on one page of its original opinion to avoid a misunderstanding of the Court's intention. As previously pointed out, the original opinion, before the correction, clearly invalidated all of the claims of the patent. The judgment entered two days later invalidated all of the claims of the patent and adopted the opinion of April 27, 1964 as the Court's findings of fact and conclusions of law. The supplemental opinion confirmed that all of the claims were in issue and recited Petitioner's attempt to have all of the claims held valid.

The trial Court had the right to correct any language in its opinion and Petitioner has not cited a single case which deprives the Court of this right. Petitioner in its brief, as well as in its oral arguments before the Court of Appeals, contended, as it does here, that the trial Court's opinion does not support the judgment holding all of the claims invalid, in view of the correction made by the trial Court. The Court of Appeals held that the trial Court's findings were adequate and were supported by substantial evidence. It further stated:

> "We find nothing improper in the trial Judge making a few changes in his opinion after it was filed, when minor inaccuracies were called to his attention. Copies of the substituted page were immediately sent to all counsel of record."

CONCLUSION

The District Court and the Court of Appeals unanimously have held that all of the claims of Patent No. 2,931,245 were in issue and that all of said claims are invalid. The Courts below have followed the standard, accepted, and usual course of judicial proceedings in such cases. The Petition does not set forth any basis upon which this Court should grant certiorari.

There is no conflict of decisions. There is no important question of Federal Law. The decisions below are clearly correct.

For the foregoing reasons it is respectfully submitted that this petition for a writ of certiorari should be denied.

Respectfully submitted,

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